

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Panu Korhonen, et al.  
Title: USER INTERFACE FOR A PORTABLE  
TELECOMMUNICATION DEVICE  
Appl. No.: 10/509,528  
Filing Date: 9/24/2004  
Patent No.: 7,593,748  
Grant Date: 9/22/2009  
Examiner: Angelica Perez  
Art Unit: 2618  
Confirmation Number: 2810

**RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM  
ADJUSTMENT UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent which issued on 9/22/2009 as U.S. Patent No. 7,593,748. The USPTO indicated in the letter mailed August 24, 2009 (copy attached as Exhibit A), that a decision on the Applicants' initial request was dismissed as premature.

The Patent Office determined that the patent was entitled to 379 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 630 days PTA, as shown on the attached sheet (Exhibit B), which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	737 days
(b) Total Applicant delay:	107 days
Final PTA Determination:	630 days

Applicants therefore respectfully request that the patent be accorded 630 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date October 22, 2009

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By \_\_\_\_\_

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**OFFICE OF PETITIONS**

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MADISON, WI 53701-1497

EXHIBIT A

In re Application of :  
Korhonen, et al. :  
Application No. 10/509,528 : ON APPLICATION FOR  
Filed: September 24, 2004 : PATENT TERM ADJUSTMENT  
Atty Docket No. 088245-0110 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705 filed March 27, 2009. Applicants submits that the correct patent term adjustment to be indicated on the patent is five hundred eighty-two (582) days, not three hundred nineteen (319) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee<sup>1</sup>.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

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<sup>1</sup> For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on November 28, 2008.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

## Patent Term Adjustment Calculation System

Add a new event to this case

EXHIBIT B

Docket Number: 088245-0110

Application Number: 10/509528

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	03/26/2002	-913		
Edit Delete	International Filing Date	03/05/2003	-569		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	09/24/2004	0		
	PCT National Stage Commencement Date	09/24/2004	0		
	14 month From Application date	11/24/2005	426		
Edit Delete	Non-Final Office Action	07/31/2006	675	249	
	Non-Final Office Action + 3 months	10/31/2006	767		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/05/2007	864		97
Edit Delete	Final Office Action	04/20/2007	938		
Edit Delete	Notice of Appeal Received at PTO	07/20/2007	1,029		
Edit Delete	Appeal Brief Received at PTO	07/20/2007	1,029		
	3 Year Period Starts	09/24/2007	1,095		
	Appeal Brief Filed + 4 months	11/20/2007	1,152		
Edit Delete	Non-Final Office Action	05/06/2008	1,320	(168)	
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	06/02/2008	1,347		
Edit Delete	Final Office Action	08/27/2008	1,433		
Edit Delete	Final Office Action Response Received at PTO	09/26/2008	1,463		
Edit Delete	Advisory Action	10/09/2008	1,476		
	Final Office Action + 3 months	11/27/2008	1,525		
Edit Delete	Request For Continued Examination (including amendment)	11/28/2008	1,526	431	1
	3 Year Period Stopped	11/28/2008	1,526		
Edit Delete	Notice of Allowance	12/31/2008	1,559		
Edit Delete	Post-Allowance Document Received at PTO	02/19/2009	1,609		
Edit Delete	Supplemental Notice of Allowability	02/27/2009	1,617		9
Edit Delete	Issue Fee Paid	03/27/2009	1,645		
	Issue Fee Paid + 4 months	07/27/2009	1,767		

[Edit](#) [Delete](#)

Patent Grant Date

09/22/2009

1,824

57

Totals:

737

107

PTA:

630



Version: 3.02.05

LOGIN: Linda Anderson

IP: 10.24.4.21

Foley &amp; Lardner LLP